

**RCE Submission Under 37 C.F.R. 1.114
Expedited Procedure Examining Group 2833**

Attorney Docket Number: DELRI/109/US

REMARKS

This Amendment is being filed under 37 C.F.R. §1.114 governing Request for Continued Examination (RCE). This Response is being filed in Response to the Office Action, dated February 26, 2003. No new claims have been added. Claims 1, 9, and 15 have been amended. Upon entry of the Amendment, claims 1-18 will be pending in the application.

Claim Objection Obviated

Objection to amended claim 15 no longer applies. Claim 15, line 1 has been amended as per the Examiner's comment. Applicant acknowledges, and verifies the dependency of the claims.

Claim Rejection under 35 U.S.C. §102

Claims 1-3, 5-8, 13 and 14 have been rejected under 35 U.S.C. §102 as being anticipated by Izraeli. Applicant notes the proper standard under 35 U.S.C. §102 for finding anticipation is that the prior art must disclose each and every limitation found in the claims, either expressly or inherently. Rockwell International Corp. v. United States, 147 F.3d 1358, 1363 (Fed. Cir. 1998); Electro Med System S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Furthermore, the omission of any claimed element no matter how insubstantial is grounds for traversing a rejection based on Section 102. Connell v. Sears Roebuck & Co., 772 F.2d 1542 (Fed. Cir. 1983).

The courts have clearly stated that inherent anticipation requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citing Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)).

Applicant asserts that Izraeli does not, at a minimum, expressly or necessarily disclose a one piece base comprising a fixed jaw, a first guide portion, and a spade connector defining an opening; and a one piece movable member comprising a

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movable jaw, a second guide portion partially defining a receiving cavity. As such, a rejection under 35 U.S.C. §102 is clearly not proper and should be withdrawn.

Claimed Invention is Non-Obvious Under a Proper 35 U.S.C. §103 Analysis

The claimed invention is additionally non-obvious with regard to Israeli since there is at a minimum no suggestion or motivation present in the teaching or disclosure of Israeli, or within the knowledge of one of ordinary skill in the art as evidenced by, at least, the references cited in the Office Action, to do what the Applicants have done in the claimed invention. For example, at a minimum Israeli does not teach or suggest a one piece base comprising a fixed jaw, a first guide portion, and a spade connector defining an opening; and a one piece movable member comprising a movable jaw, a second guide portion partially defining a receiving cavity. Applicant notes that as thoroughly discussed in a recent court holding:

"...the essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors)." In re Lee, 61 USPQ2d, 1430 (Fed. Cir. 2002)

Such a rigorous examination required by law clearly would find the claimed invention non-obvious based on at least a study of the problem to be solved by the Applicant, and the functionality of the claimed invention.

Claim Rejections Under 35 U.S.C. §103, Prima Facie Case Not Established

Claims 4, 9-13, and 16-18 were rejected under 35 U.S.C §103(a). Claims 9-13, and 16-18 were rejected as being obvious over United States Patent No. 4,768,963 to

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Barron in view of United States Patent No. 4,103,986 to Israeli. Claim 4 was rejected as being obvious over Israeli alone. The Office Action has failed to establish a *prima facie* case.

To establish the legal conclusion of a *prima facie* case of obviousness, three (3) basic criterions must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations. A *prima facie* case of obviousness "means not only that the evidence of the prior art would reasonably allow conclusion the examiner seeks, but also that the prior art compels such a conclusion if the Applicant produces no evidence or argument to rebut it". In re Spada, 911 F.2d 705,708 n.3, 15 USPQ 2d 1655, n.3 (Fed. Cir. 1990). It is well recognized that due caution should be exercised by an Office Action in constructing a conclusion of obviousness by combining references.

Applicant respectfully notes that the combination of features found in the cited references in this case should be carefully examined. The courts have clearly stated that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill. In re Hedges, 783 F.2d 1038, 228 USPQ 685, 687 (Fed. Cir. 1986), citing In re Wesslau, 353 F.2d at 241, 147 USPQ at 393.

All Claim Limitations Are Not Taught Or Suggested

It is well established that when even one claimed limitation is not found in the combination of prior art, a rejection under 35 U.S.C. §103 is improper. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Barron reference discloses a ground connector that does not have a one piece base comprising a fixed jaw, a first guide portion, and a spade connector defining an opening; a one piece movable member comprising a movable jaw, a second guide

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portion, and a receiving cavity, said receiving cavity at least partially defines the second guide portion, which includes the first guide portion and said second guide portion having a pair of opposing ribs and a pair of opposing channels which cooperate with said ribs. The Israeli reference is also devoid of these features.

The combination of Barron and Israeli as suggested in the Office Action simply does not yield, at the least, the Applicants claimed invention of a one piece base comprising a fixed jaw, a first guide portion, and a spade connector defining an opening; a one piece movable member comprising a movable jaw, a second guide portion, and a receiving cavity, said receiving cavity at least partially defines the second guide portion, which includes the first guide portion and said second guide portion having a pair of opposing ribs and a pair of opposing channels which cooperate with said ribs. Since all of the claimed elements are clearly not present in the modification or combination as suggested, the claimed invention is non-obvious for at least this reason.

Examiner Has Misapplied In re Hotte

Applicant notes the Examiner's position, as stated on page 6 of the Final Office Action, that "constructions united by means such as fastening and welding are considered one component. In re Hotte, 177 USPQ 326, 328 (CCPA 1973)". Applicant believes that the Examiner has misread Hotte, since this is an incorrect statement of the case. The court in Hotte distinguishes "integral" from the more restrictive phrase "one piece". Hotte, at 328. The court in Hotte states that it is "integral" which is "sufficiently broad to embrace constructions united by means as fastening and welding." Hotte at 328. It is clear, from Hotte, that "one piece", is not to be construed in this manner. As such, it is Applicant's belief that upon rereading Hotte, the Examiner will appreciate the inapplicability of Israeli in support of the present rejection.

Motivation Or Suggestion To Combine The References Not Found

To properly combine the references of Barron and Israeli in an effort to reach the conclusion that the subject matter of the claimed invention would have been obvious, requires some teaching, suggestion or inference in either, or both, the Barron and Israeli

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references, or within the knowledge generally available to one of ordinary skill in the relevant art, which would lead one skilled in the art to make the proposed combination.

The Office Action asserts, in the Final Office Action, that motivation to combine the references is “**because these two connectors were art-recognized equivalents**” (emphasis added) at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute of the connector of Israeli for the connector of Barron to complete the ground connection”. Page 5, Final Office Action. This is clearly not a proper motivation or suggestion to combine or modify the reference teachings.

A statement or suggestion of “art-recognized” equivalency is not found anywhere in the Barron or Israeli references. The Examiner appears to be applying a “general knowledge” assertion to negate patentability. As stated by the courts, this, by itself, is improper since:

“The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. [When] the examiner and the Board . . . rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.” In re Lee, 61 USPQ2d, 1430 (Fed. Cir. 2002).

The Applicant therefore requires that the Examiner provide a statement supporting the statement that these references are “art-recognized equivalents”. If this statement by the Examiner is not found in prior art reference(s), and is instead based on the knowledge of the Examiner, then the Applicant herein requires the Examiner to supply an affidavit conforming to 37 C.F.R. §104(d)(2).

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The References Teach Away From Each Other

There is, additionally, no motivation or suggestion to combine or modify the references of Barron and Israeli since they teach away from each other. It is a well-established "general rule" that references that teach away cannot serve to create a *prima facie* case of obviousness. In re Gurley, 27 F3d 551, 553, 31 USPQ 2d 1131, 1132 (Fed Cir. 1994). A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the Applicant." Winner v. Wang, 202 F.3d 1340 (Fed Cir. 2000) citing Gurley at 553.

In considering the references, the Barron reference is directed toward a ground connector that does not have a one piece base comprising a fixed jaw, a first guide portion, and a spade connector defining an opening; a one piece movable member comprising a movable jaw, a second guide portion, and a receiving cavity, said receiving cavity at least partially defines the second guide portion, which includes the first guide portion and said second guide portion having a pair of opposing ribs and a pair of opposing channels which cooperate with said ribs. The relevant teaching in Barron is clearly toward the use of a screw member to retain a wire in place. See Barron Abstract. The Israeli reference also does not have a one piece base comprising a fixed jaw, a first guide portion, and a spade connector defining an opening; a one piece movable member comprising a movable jaw, a second guide portion, and a receiving cavity, said receiving cavity at least partially defines the second guide portion, which includes the first guide portion and said second guide portion having a pair of opposing ribs and a pair of opposing channels which cooperate with said ribs. Instead, the relevant teaching from Israeli is directed toward combining numerous complex and interrelated components to retain a wire with a free floating pressure plate.

The combination of Barron and Israeli as suggested in the Office Action simply does not flow from the line of development found in Barron and Israeli. One of ordinary skill in the art having these two references before them would find them non-productive for the purpose of creating a ground connector installation as claimed by the Applicant. A *prima facie* case of obviousness is not established for at least this additional reason.

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Proposed Modification Renders The Barron Invention Unsatisfactory for its Intended Purpose.

The MPEP at §2143.01 states. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" The claimed invention of claims 9-13, and 16-18 is a ground connector assembly for use in grounding a distribution transformer wherein the device is mounted by a bolt extending through said opening into ground connecting means. The prior art Barron reference concerns a ground adapter wherein the ground adapter is "threadedly positioned in a recess or aperture in a metal object to be grounded", and wherein the ground adapter has an integral threaded portion of "typical sizes for commercial use". Column 1 lines 50-60, column 3 lines 25-63. The reference further teaches that the ground adapter comprises "a conductive body having a threaded cylindrical end portion". If the teaching found in the Barron prior art device were modified with a spade end which is as suggested is non-cylindrical and non-threaded, it would be inoperable for its intended purpose because it could no longer be threaded to a threaded opening in the object to be grounded. A *prima facie* case of obviousness is not established for at least this additional reason with regard to at least claims 9-13, and 16-18.

Change to the Basic Principle of Operation of Barron Improper

The MPEP at §2143.01 is also clear that the proposed modification cannot change the basic principle of operation under which the prior art reference operates. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The claimed device is mounted by a bolt extending through said opening into ground connecting means. The primary Barron reference teaches a ground adapter wherein the device is to have "a conductive body having a

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threaded cylindrical end portion". Barron teaches that the device requires the threaded portion so that the device could be directly threaded into the object to be grounded, whereas the claimed invention of claims 9-13, and 16-18 requires a bolt extending through an opening in the device for mounting. The suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the Barron reference as well as a change in the basic principle under which the Barron construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.). A *prima facie* case of obviousness is not established for at least this reason with regard to at least claims 9-13, and 16-18.

Rejection of Claim 4 and 12 Under 35 U.S.C. §103 Does Not Meet Legal Requirements

The Examiner has cited the case of In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), for the supposed rule that "rearranging parts of an invention involves only routine skill in the art." Final Office Action, page 5. This statement is merely conclusory since the courts have clearly held that there are no *per se* rules of unpatentability. In re Durden 226 USPQ 359, 362 (Fed. Cir. 1985); In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) ("The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention, including all its limitations with the teachings of the prior art, flouts Section 103 and the fundamental case law applying it."); In re Cofer, 354 F.2d 664, 667, 148 USPQ 268, 271 (CCPA 1966) ("[I]t is facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. § 103."). Each claimed invention must be considered on its own merits and in every instance, the test for patentability under § 103 is the same: "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention." In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The Examiner is respectfully reminded that "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's

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specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

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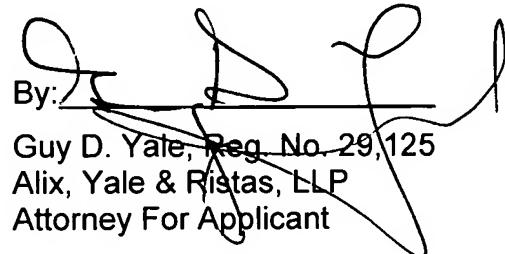
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In summary, Applicant has addressed each of the rejections within the present Office Action either by Amendment or Remarks. It is believed the application as amended now stands in condition for allowance, and prompt favorable action thereon is earnestly solicited.

Respectfully submitted,

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